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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,238	03/02/2002	Rong Xiang	TSRI 830.0	6584

7590 05/05/2004  
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Chicago, IL 60606

EXAMINER

LI, BAO Q

ART UNIT PAPER NUMBER

1648

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/090,238	<b>Applicant(s)</b> XIANG ET AL.	
	<b>Examiner</b> Bao Qun Li	<b>Art Unit</b> 1648	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,8-11,16-18 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 8-11, 16-18, and 36-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Amendment***

This is a response to the amendment, paper No. 9, filed 02/18/04. Claims 1, 10, have been amended. New claims 36-42 are added. Claims 2-7, 12-15 and 19-35 have been canceled. Claims 1, 8-11, 16-18 and 36-42 are pending and considered before the examiner.

Please note any ground of rejection(s) that has not been repeated is removed. Text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

### ***Declaration under 37 CFR 1.131***

1. The Declaration by Rong Xiang and Ralph A. Reisfeld, paper No. 8 filed on February 18, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the 103 reference.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5, 8-13, 16-18, 20 and 36-42 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Xiang et al. (J. Immunol. 2001, Vol. 167, pp. 4560-4565) and Weiner et al. (WO 99/43839A1) on the same ground as stated in the previous Office Action.
4. Applicants filed a Declaration under **37 CFR 1.131**, and submit an original manuscript, which contains same content of the 102 (a) reference cited by the previous Office Action. The manuscript also has the same authorships as that of cited reference by Rong Xiang, F. James, Primus, J. Michael Ruehlmann, Andreas, G, Neithammer, Steve Silletti, Holger N. Lode, Carrie S. Dolman, Stephen D. Gillies and Ralph A. Reiself. Applicants further contest that prior to October 15, 2001, in the United states of America, we had conceived, prepared and successfully

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tested a DNA vaccine effectively for eliciting an immune response against cells that present a carcinoembryonic antigen (CEA) comprising a plasmid DNA operably encoding a CEA; and a plasmid DNA operably encoding a CD40 ligand, together with a pharmaceutical acceptable carrier. Applicants also state that the other authors listed on the Xiang et al. publication and on the manuscript reproduced in Exhibition A did not contribute to the invention claimed in the above identified application.

5. Applicants' argument has been fully considered; however, it is not persuasive because a manuscript submitted in Exhibition A represents the same work as disclosed in the current application by the same group of people of Rong Xiang et al. The statement on paragraph 8 in the Declaration is merely a conclusion, which is not an evidence to support that the other authors appeared in the manuscript as well as the publication do not contribute the work.. The declaration is not properly filed to convince the Office that submitted manuscript and prior art cited by the Office were only contributed by the two inventors rather than a group of people together listed in the publication and manuscript.

6. Because the Declaration filed on 02/18/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the 103 (a) reference for the reason stated above, the rejection is maintained.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Qun Li whose telephone number is 571-272-0904. The examiner can normally be reached on 7:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bao Qun Li

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April 22, 2004

*James C. Housel*  
5/3/04